

**REMARKS/ARGUMENTS**

**Status of the Application:**

Prior to entry of this amendment, claims 1-26 are pending in the application. Claims 1-18, 20 and 21 stand rejected under 35 U.S.C. § 102(e) as anticipated by U.S. Patent No. 5,982,412 (Nulty), and claims 12-14, 17-26 stand rejected under § 102(e) as anticipated by U.S. Patent No. 5,835,565 (Smith). This amendment neither amends nor cancels any claims, but new claim 27 has been added. Hence, after entry of this amendment, claims 1-27 will be pending in the application.

**Amendments:**

This amendments correct typographical errors in paragraphs 25 and 26 of the written description. In addition, this amendment has added new claim 27, the elements of which are supported by, *inter alia*, original claim 12.

**Claim Rejections:**

As noted above, all pending claims stand rejected under § 102(e) as anticipated by Smith, Nulty or both references. The applicant respectfully traverses these rejections and submits that neither Nulty nor Smith, taken either alone or in combination, teach each of the limitations of the rejected claims and, therefore, that these references properly cannot form the basis of a rejection under § 102(e). The rejections under each reference will be addressed respectively below.

**1. The Nulty Reference**

The office action asserts that Nulty discloses each of the elements recited in claims 1-18, 20 and 21 of the present application. As the argument below illustrates, however, Nulty fails to disclose each element of independent claims 1, 6, 7, 12 and 20, let alone the additional elements of the claims depending therefrom. Consequently, the applicant respectfully submits that Nulty properly cannot form the basis of a § 102 rejection for any of the claims. Moreover, since there is no suggestion or motivation to modify Nulty to include each of the

limitations of the rejected claims, Nulty properly cannot serve even as the basis for a § 103 rejection of the claims at issue here.

Claim 1 recites, *inter alia*, that “the host terminal is operable to . . . authorize access to the test signal; wherein authorizing access to the test signal is based at least in part upon receiving a network sign-on identifier via the user drop.” While the office action correctly points out that Nulty (c. 7, ll. 33-35) does disclose that “[a]n encryption key and unique address for each coaxial network interface unit 116 on a broadband network may also be provided to enhance security on the broadband network,” Nulty fails to disclose, or even suggest, that either the encryption key or the network address could serve as a network sign-in identifier as claimed in claim 1, let alone that a host terminal ever receives either the encryption key or the network address via the user drop as part of an authorization scheme.

Instead, Nulty (c. 7, ll. 36-38) discloses that the purpose of the key and address is to ensure that “coaxial network interface unit 116, command, control and data transfer cannot easily be interpreted and modified.” Thus, while Nulty does not disclose exactly how the key and/or address are used, the most plausible interpretation of the disclosure is that the operator of the test apparatus provides a destination address and/or encryption key to the test apparatus, which then encrypts the command, control and other data with the key and transmits the data to that address, without ever having received any “network sign-on identifier via the user drop” as recited in claim 1. Thus, Nulty reasonably cannot be read to disclose—either expressly or inherently—this element of claim 1. Further, because Nulty incorporates these security features, there would be no need for Nulty’s system ever to receive a network sign-on identifier from a user drop, thus eliminating any suggestion or motivation to modify Nulty to operate in this manner. For at least this reason, Nulty fails either to anticipate or render obvious claim 1, and claim 1 therefore is allowable over Nulty. For at least similar reasons, independent claims 6 and 7 are allowable over Nulty as well. Dependent claims 2-5 and 8-11 are allowable as depending from allowable base claims as well as by being directed to specific novel substitutes.

While the office action asserts that “[c]laim 12 is rejected for the same reasons as claim 6, claim 12 includes at least one element not present in claim 6, “wherein the signal

comprises a first signal type and a second signal type,” that the office action fails to address in its entirety. Moreover, a review of Nulty’s disclosure fails to reveal anything that reasonably could be interpreted to teach this limitation. In the absence of a rejection addressing this element of claim 12, it is assumed that claim 12 is allowable over Nulty for at least this reason, and claim 12 will not be addressed in further detail herein.

It is worth noting, however, that claims 13-18 each contain additional elements also not disclosed by Nulty, and that those claims are allowable as depending from claim 12 as well as by virtue of the additional elements. Merely by way of example, claim 14 recites “coupling a display to the test device, wherein the video signal is displayed.” In rejecting this claim, the office action cites the televisions 115, 118 shown on Fig. 1 of Nulty. Clearly, however, these devices are not coupled to the test device (105), but instead are located in the subscriber premises. Moreover, Nulty does not appear to disclose anything about the display on these devices of a video signal received at the test device via the user drop, as recited in claim 12 and incorporated by reference in claim 14. Indeed, it would be difficult to fathom how these televisions, which clearly are remote from the test device, could be used to display a signal received at the test device. For at least this additional reason, claim 14 is allowable over Nulty.

Finally, the Office Action cites Nulty in rejecting claim 20, which recites, *inter alia*, that “the test device comprises . . . at least one input/output port . . . wherein the input output port is configured to provide access to the test device via an external input/output device.” In supporting this rejection, the office action cites column 9, lines 43-52 of Nulty. The cited passage, however, fails to describe the test device at all, however. Instead, that passage describes how customer equipment (137) can be configured for bidirectional reception/transmission of broadband signals. It is difficult to understand how this passage possibly could be read to disclose the element of claim 20 to which it is attributed, as it discusses neither a test device nor any input/output port configured to provide access via an external input/output device. Moreover, nothing else in Nulty’s disclosure appears to teach, or even to suggest, this element, and the applicant respectfully submits that claim 20, is allowable over Nulty.

Additionally, Nulty fails to disclose the elements of claim 21, which recites that “the test device is configured as a set-top box with a unique type and subtype value stored therein.” In fact, the test device of Nulty appears to be located at the cable TV head end, such that it would be counterintuitive for the test device to be a set-top box, which Nulty discloses is located at the customer premises. *Compare* Nulty, Fig. 1, refs. 105, 122 (showing location of testing center), *with* Nulty, c. 4, ll. 27-32 (describing how a “set top decoder” can be connected via “inside wiring” to a network interface unit 116 located at the private residence 109). For this additional reason, as well as its dependence from claim 20, claim 21 is allowable over Nulty.

## **2. The Smith Reference**

Claims 12-14, 17-26 stand rejected under § 102(e) as anticipated by Smith. The applicant respectfully submits, however, that Smith fails to teach even the limitations of independent claims 12 and 20, and that Smith therefore properly cannot be used as a § 102 reference with respect to the rejected claims. In fact, as argued below, there does not even appear to be any motivation or suggestion to modify Smith in such a way as to render even independent claims 12 and 20 obvious over that reference.

For example, claim 12 recites, *inter alia*, “receiving a signal at the test device” and “measuring the signal to determine the performance capability of the user drop.” Smith does not teach these elements. Instead, the portion of Smith (c. 2, ll. 39-43) quoted in the Office Action discloses that “a plurality of response data including voice and digital data are produced by the system under test in response to the subsequent test data. The response data are then compared with expected response data for determining whether or not the system under test is operating properly.” While on its face, this disclosure may seem similar to the quoted portions of claim 12, a closer analysis of Smith reveals the dissimilarities. For example, Smith (c. 6, ll. 3-7) discloses that “most commands executed by tester 100 return what is commonly known as an event, which is the lowest-level action or response that can be recognized by either tester 100 or telecommunication system 102.” Thus, the testing system of Smith appears to operate by receiving notice of an event performed by the system under test, and comparing that event with an anticipated event.

One example of this functionality is described at column 10, lines 30-35, where Smith discloses a test in which “tester 100 may place a plurality of outbound calls to telecommunication system 102, and then obtain a call history log from local user switch 106. By analyzing this call history log, tester 100 can determine whether local user switch 106 processed the plurality outbound calls correctly, thereby determining whether local user switch 106 is defective.” Clearly, the analysis performed by the tester in this example does not include the measurement of a signal, but rather an evaluation of data about the switch’s routing of calls.

Another example is described at column 9, lines 25-27, where Smith discloses that a COMM\_ERROR event may be generated by the system under test, and that the event may be “queried” to determine specific information about the error. Again, this example amounts to analysis of data returned by the system under test, not the measurement of any signal. In fact, although Smith describes numerous other examples of data analysis performed by its disclosed system, none of them fairly can be described as “measuring [a] signal to determine the performance capability of the user drop.” In fact, most, if not all, of Smith’s examples deal with measuring the response of a telecommunication system (switch, PBX, etc.), not a user drop. For at least this reason, Smith fails to disclose each of the recited elements of independent claim 12, and Smith therefore fails to anticipate that claim. In fact, given Smith’s reliance on testing events, it would not be obvious (if even possible) to modify Smith in such a way as to render claim 12 unpatentable over that reference.

Dependent claims 13-4 and 17-19 likewise are allowable, as they depend from allowable base claim 12. In addition, each of those claims recites additional novel limitations not disclosed by Smith. Merely be way of example, claim 13 recites that “the first signal type is a video signal and the performance capability comprises a video performance capability, and claim 14 recites “coupling a display to the test device, wherein the video signal is displayed.” While the cited portion of Smith (c. 11, ll. 30-33) does make passing reference to video data, Smith nowhere discloses that the “video data” might be a video signal that could be tested according to the method of claim 12, and Smith fails utterly to provide any disclosure that could be considered even remotely to enable one of skill in the art to use Smith’s system actually to test video performance capability.

Similarly, while Smith (c. 10, ll.43-53) discloses the use of a computer monitor to display data as a “screen pop,” merely displaying digital data in a graphical format on a computer screen cannot be understood to disclose (either expressly or inherently) displaying a video signal. This can be seen by the fact that Smith discusses the “screen pop” only in the context of placing an outbound call and displaying data regarding the call on the screen pop, allowing easy comparison of that data with expected values. Moreover, as Fig. 1 illustrates, the personal computer (116) controlling the screen is not part of the tester (100) but instead part of the telecommunication system under test, and in fact is part of the apparatus being tested. See Smith, c. 10, ll. 49-53 (noting that the tester can determine “whether either local user switch 106, file server 114 or personal computer 116 is defective” (emphasis added)). Smith, therefore, clearly fails to disclose the limitations of either claim 13 or 14, and those claims are allowable for at least these additional reasons.

Smith likewise fails to disclose the limitations of independent claim 20. Assuming, *arguendo*, that Smith does disclose that its tester has a user drop port for receiving information via the user drop, the cited portion of Smith (c. 2, ll. 33-59) nowhere discloses that Smith’s tester includes “at least one input/output port . . . configured to provide access to the test device via an external input output/device,” as recited in claim 20 (emphasis added), and a review of Smith’s remaining disclosure likewise fails to show anything that could be considered to read on this element of claim 20. In fact, while Fig. 2 of Smith does show several ports, each of those appear to be connected to the telecommunication system under test, not to an external input/output device. This can be seen clearly by Fig. 1, which illustrates that the tester (100) may have several connections to the telecommunication system (102), but no connections to any external devices. Given the apparent ability for Smith’s tester to test, on its own, all desired aspects of the telecommunication system under test, there would appear to be no motivation to connect the tester to any external device in any event. Thus, for at least this reason, claim 20 is allowable over Smith.

Likewise, dependent claims 21-26 are allowable as depending from allowable base claim 20, as well as reciting additional novel elements. Merely by way of example,

dependent claim 21 recites that “the test device is configured as a set-top box with a unique type and subtype value stored therein.” Nowhere does Smith disclose that its tester can be a set-top box—in fact, such a conclusion would be counter-intuitive, since Smith’s tester appears to be designed primarily (if not solely) for a voice and/or data communication system, where a set top box would be useless, not a video distribution system, where a set-top box normally would be more appropriate. Further, even if Smith’s tester somehow could be considered a set-top box, Smith still fails to disclose that the tester could have a unique type and subtype value stored in the tester.

Similarly, Smith fails entirely to disclose or even suggest the limitations of claim 22, which recites, *inter alia*, that the “input/output port is an output port associated with an MPEG video decoder.” In fact, Smith appears not even to discuss the testing of MPEG signals, let alone provide any facility for an MPEG decoder, probably because, as discussed above, Smith seems to be directed to testing voice/data systems and appears not to contemplate (other than a passing mention) the testing of any video capabilities whatsoever. For at least reasons similar to those discussed above, claims 23-26 are allowable over Smith as well. New claim 27, which incorporates elements similar to those recited in claim 12, is allowable for at least the reasons discussed with respect to both claims 12 and 20.

Finally, it is worth mention that there would be no motivation to combine Smith with Nulty, not the least because the combination would appear to be utterly inoperable. As mentioned above, Nulty is directed to the testing of coaxial video systems, while Smith is directed to the testing of (presumably twisted pair) voice and/or data systems. For at least the reasons stated above, therefore, Smith and Nulty, taken either alone or in combination, fail to teach or suggest the limitations of any pending claim

### CONCLUSION


In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

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PATENT

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 303-571-4000.

Respectfully submitted,

  
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